



George

PATENT
Customer Number 22,852
Attorney Docket No. 05552.1450

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Carsten SCHELP et al.) Group Art Unit: 1641
)
Application No.: 10/024,258) Examiner: D. Davis
)
Filed: December 21, 2001)
)
For: DETECTION METHODS)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated March 23, 2004, the Examiner required
restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I: Claims 1-18 and 23-26, drawn to a method and kit for detecting an
analyte A in a sample, classified in class 435, subclass 4; and

Group II: Claims 19-22 and 27-31 drawn to a method of detecting an analyte
A in a sample, classified in class 436, subclass 518.

Applicants elect, with traverse, the subject matter of Group I, claims 1-18 and 23-
26.

The Examiner alleges that Group I is distinct from Group II because Groups I and
II have different effects. In particular, the Examiner alleges that Group I and Group II

utilize different reagents; and the binding relationship of R3 is different. Although the inventions of Groups I-II may be independent or distinct as claimed, Applicants respectfully submit that the Restriction Requirement between Groups I-II is improper and should be withdrawn.

According to MPEP § 803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is required" (Emphasis added). Applicants respectfully submit that the Examiner has failed to establish the second requirement set forth in MPEP § 803, that a serious burden exists on the Examiner if restriction is required between Groups I and II.

In the Office Action, at page 2, the Examiner alleges that the examination of Groups I and II will require a search of two different classes. Applicants respectfully point out to the Examiner that there is considerable overlap between the two classes in their subject matter which does not justify the notion that it would be a serious burden to simultaneously search all claims within Applicants' invention. For instance, class 435, subclass 4, is directed to "[p]rocesses in which there is a direct or indirect qualitative or quantitative measurement or test of a material which contains an enzyme or microorganism . . . the enzyme can be free or immobilized or present in a cell, tissue, or organ . . . compositions herein may include . . . carriers" (Emphasis added). Class 436, subclass 518, entitled "Involving An Insoluble Carrier for Immobilizing Immunochemicals", is directed to "subject matter in which an immunological test is

carried out using an antigen, antibody or fragment thereof" (Emphasis added.)

Accordingly, Applicants respectfully assert that the examination of Group II will overlap with the examination of Group I.

MPEP § 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims directed to distinct or independent inventions." (Emphasis added). As discussed above, there would be considerable overlap between the examinations of Groups I and II, and it is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 23, 2004

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